

**REMARKS****CLAIM OBJECTIONS**

**Regarding Claim 3, it was amended for clarification. The claim was amended to depend from Claim 1.**

**Regarding Claim 7, it was amended for clarification. The claim was amended to depend from Claim 1.**

**Regarding Claim 9, it was amended for clarification. The claim was amended to add "a" before "memory device".**

**112 REJECTIONS**

**The examiner makes a statement that one skilled in the art would not understand specifications without any evidence on the record. Thus, the applicant is requesting that the examiner defines the level of one skilled in the art. Then, define why this hypothetical person would not be able to understand claims 1, 3, 14, 15 and 16. As here, the specifications were written to one with skill in the art. It is not required that the applicant defines each and every detail in the specifications. See *Verve LLC v Crane Cams Inc.*, 311 F.3d 1116, 65 USPQ2d 1051, 1053-54 (Fed. Cir. 2002).**

**Regarding Claim 13, Fig. 2 shows the image holder contained within the support base. Both the image holder and the support base in this particular configuration is circular. The structure of the image holder corresponds to the support base to allow the support base to connect and support the image holder. Fig. 4A illustrates one embodiment of the image holder. The image holder has an opening to support a**

connection to the support base. This is a conventional type of connection between the image holder and the support base. Additionally, claim 13 depends from claim 1 where "a support base" is defined. Claim 13 depends from claim 9 which depends from claim 8 which depends from claim 1. Thus, the antecedent basis is defined. Examiner took judicial notice of a CD-ROM. However, the image holder is not a CD-ROM. It is circular like a CD ROM with a opening in the middle to support the connection to the support base. However, the image holder of this invention is not a CD-ROM.

Regarding Claim 14, the term "the" was changed to "a" for antecedent basis.

Regarding Claim 15, "a graphics data stream was defined on line 4 which supports line 7 "the graphics data stream".

Regarding Claim 16, it was amended for clarification. However, there is a difference in structure between a video stream (contains moving pictures and sound) and a graphic stream (can contain pictures only). One skilled in the art would understand that based upon the actual structure of the data stream selected, a corresponding video or graphic data stream is generated.

## 102 REJECTIONS

Examiner noted that claims 1, 2, and 8-15 were rejected as being anticipated by Fitch. The reference must describe every detail of the claimed invention. (See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed Cir. 1983)). Additionally, the reference must adequately describe the claimed invention to put it in the public domain (See *In re Zenitz*, 333 F2d 924, 142 USPQ

158, 160 (C.C.P.A. 1964)). The description must enable a person with ordinary skill in the art not only to comprehend the invention but also make it. (See *Paperless Accounting, Inc v. Bay Area Rapid Transit Sys.*, 804 F.2d at 665, 231 USPQ at 653) The reference must teach the claimed invention. (See *Ex parte Fujishiro*, 199 USPQ 36 (Pat. Off Bd. App. 1977)).

*Here, Fitch is a completely digital device. Applicant has claimed a mechanical device connected with a digital device. Applicant claimed an image holder mounted within a support base. Additionally, Applicant claimed a mechanical actuator that controls the selection of the image from the image holder. The Webster dictionary defines an actuator as a mechanical device for moving or controlling something. Mechanical is defined as of or relating to manual operations. Claims language should be given its ordinary meaning. The specifications state that the actuator allows the user to rotate the image holder until the desired image is chosen. Fig. 2 shows the image holder contained within the support base.*

*Examiner noted in Fitch as 32, 42 as the image holder, 30 as the mechanical actuator, 24 as the support base, column 2, and lines 34-37 as the selection indicator. 42 is a plurality of image holders that are externally connected through a parallel interface. See also column 3 lines 40-45. They are accessories and not integrated into the device. Thus, they cannot be contained within a support base. Video switch 30 is digital and automatically controlled by the microcontroller for selecting among a plurality of analog storage devices. These storage devices are not contained within the support base. Thus, 30 cannot be a mechanical actuator that controls the mechanical selection of images from an image holder. Video switch 30 is not even connected to 42. Applicant submits that Examiner has not established a prima facie case of anticipation. Fitch does not describe in detail the Applicants claimed invention.*

## 103 REJECTION

Examiner noted that claim 16 was rejected under 103 by Fitch in view of Palamides. Examiner rejected claim 3 and 4 in view of Metcalf. Claim 5 and 6 in view of Post. Claim 7 in view o f Farrell.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990))

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination (See *In re Geiger*, 815 F2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)).

There must be some reason given the prior art why one of ordinary skill in the art would have been prompted to combine the teachings of the references to arrive at the claimed invention. (See *In re Regel* 188 USPQ

References that teach away cannot serve to create a *prima facie* case of obviousness. (See *In re Gurlsey*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir 1994)) In If references taken in combination would produce a "seemingly inoperative device", we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness. (See *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244)

Obvious to try standard is an improper standard (See *In re Lindell*, 385 F.2d4 453, 155 USPQ 521 (C.C.P.A. 1967)) It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. An obvious rejection cannot be based upon

hindsight and the specific teaching must come from the prior art. (See *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 178, 1784 (Fed. Cir. 1992). The claimed invention must be considered as a whole.

Examiner's may not use as an element of the obvious rejection that one skill in the art would arrive at the invention trying different alternative structures or materials (See *In re Lindell*, 385 F.2d 4 453, 155 USPQ 521 (C.C.P.A. 1967) that which is within the capability of one skilled in the art is not synonymous with obvious. Levengood teaches that an obvious rejection cannot be predicated on the fact that one skilled in the art would have the capability to arrive at the invention. Thus, that one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound reasoning does not afford the basis for an obvious conclusion (See *Id.*, 123USPQ at 352).

*Here, as explained in detail above by the Applicant under the 102 rejection section of this response, Fitch is structured significantly different than the applicant's claimed invention. Examiner has not viewed the claimed invention as a whole. Applicant utilizes a mechanical actuator to interface with an image holder containing memory devices. The actuator controls the rotation of the image holder. Fitch does not suggest or provide the motivation to utilize a manual actuator to control the selection of the image from the image holder. The applicant discloses an image holder containing a plurality of image devices rotationally mounted within a support base. See Figure 4A. There is no suggestion or desirability in Fitch to go to the structure claimed by the Applicant. Palamides also has digital connections. Palamides does not teach or disclose the manual rotation of an image holder. There are buttons in Palamides, but it does disclose or suggest a connection between the buttons and the rotation of an image holder. Without the Applicant claimed invention and disclosure, there would be no linkage to a mechanical actuator controlling the rotation of an image holder. Therefore, Applicant submits that Examiner has not made a prima facie case of obviousness.*

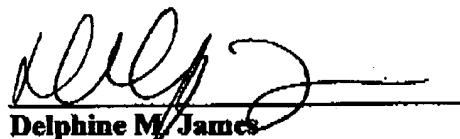
**NEW CLAIMS**

*Claim 18 was added to support the functionality of the actuator controlling the rotation of the image holder. Support for this claim is in on Page 4 lines 16-21.*

*Claim 19 was added to support the PDA functionality. This is illustrated in FIG. 4A. Drawings are considered part of the specifications.*

Applicant respectfully requests that the rejections be withdrawn. Alternately should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned.

**Respectfully submitted:**



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